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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,951	06/18/2008	Joseph Noozhumutry Varghese	R1CE-048	1562

24353 7590 09/10/2010

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EXAMINER	
WEGERT, SANDRA L	
ART UNIT	PAPER NUMBER
1646	
MAIL DATE	DELIVERY MODE
09/10/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/582,951	VARGHESE ET AL.	
	Examiner	Art Unit	
	SANDRA WEGERT	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2008*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *89-106* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *89-106* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 89-101, drawn to a cytokine binding domain comprising a first FnIII domain and a second FnIII domain.

Group II, claim(s) 102, drawn to polynucleotides encoding binding moieties comprising a cytokine binding domain.

Group III, claim(s) 103-106, drawn to a method of selecting a binding moiety with an affinity for a target molecule.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The first claimed invention lacks a special technical feature because it fails to distinguish the claimed invention from the prior art (Phylos, Inc., 2002, WO 2002/032925, of record 08/11/2006). The prior art discloses cytokine binding domains derived from fibronectin type III (fnIII) domains that have been modified in order to bind many different cytokines (see the summary at p. 2, as well as the claims).

PCT Rule 13.2 defines special technical features as technical features that identify a contribution which each of the claimed inventions, considered as a whole, makes over prior art. Claim 89 is anticipated by prior art. Therefore, claim 1 lacks a special technical feature and cannot share one with the other claims.

Likewise, the nucleic acids encoding the binding moieties lack the same technical feature as group I. In addition, the method of selecting a binding moiety requires different products, thus making them functionally different from each other. Lack of unity is shown because these methods lack a common utility which is based upon the common structural feature which has been identified as the basis for that common utility.

Species Elections

This application contains claims directed to more than one species of the generic inventions. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

If applicant elects any of Inventions I-III, applicant is required to elect two species from the following:

1) Choose two sources of extracellular domains (applicant may choose two of the same molecule or two different molecules):

a) IL-2 receptor,

b) IL-3 receptor,

c) IL-4 receptor,

d) IL-5 receptor,

e) IL-6 receptor,

f) IL-7 receptor,

g) IL-9 receptor,

h) IL- 11 receptor,

i) IL- 12 receptor,

j) IL- 13 receptor,

k) IL- 15 receptor

l) IL-21 receptor,

m) G-CSF receptor,

n) GM- CSF receptor,

o) LIF receptor,

p) oncostatin M receptor

q) cardiotrophin CT-1 receptor,

r) ciliary neurotrophic factor (CNTF) receptor,

s) prolactin receptor,

t) leptin receptor,

u) erythropoietin receptor,

v) growth hormone receptor,

w) cytokine receptor-like factor 1,

x) class 1 cytokine receptor,

y) thymic stromal lymphopoietin protein receptor,

z) gp 130.

Claim(s) 89 is generic to the disclosed patentably distinct species of receptor domains. The species are independent or distinct because they lack a common special technical feature. In addition, these species are not obvious variants of each other based on the current record.

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:

The search for one domain or a pair of domains will not necessarily reveal art relevant to the other domains.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Rejoinder

The examiner has required restriction between product and process claims. Where applicants elect claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of

the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (571) 272-0895. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Nickol, can be reached at (571) 272-0835.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

/SLW/
1 September 2010